



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

JANNES et al

Atty. Ref.: 2551-58

Serial No. 09/787,000

Group: 1648

Filed: March 13, 2001

Examiner: Foley

For: IDENTIFICATION OF MICROORGANISMS CAUSING ACUTE RESPIRATORY
TRACT INFECTIONS (ARI)

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May 8, 2006

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attn: Jasmine Chambers
Group Director TC1600

Sir:

**SECOND REQUEST FOR RECONSIDERATION AND CLARIFICATION OF
DECISION MAILED JUNE 18, 2004 AND REQUEST FOR WITHDRAWAL OF
RESTRICTION REQUIREMENT**

Reconsideration and clarification of the Decision mailed June 18, 2004
(hereinafter "Decision") is again requested for the following reasons.

The undersigned has not received a response to a similar Request filed
August 18, 2004.

Moreover, reconsideration and withdrawal of the restriction requirement, at
least in so far as it pertains to claims 37-41, 43-46 and 48-49, are requested, as the
Examiner has indicated that the products of these claims (i.e., the primers according

to claim 17 (and 36)) have been examined and found allowable over the art. See page 8 of the Office Action of November 7, 2005.

Rejoinder and allowance of at least claims 37-41, 43-46 and 48-49 with claims 13, 15, 17-21, 23-25, 27-31, 33 and 35-36 are requested as if the Examiner has examined the products of these claims and found them allowable, requiring prosecution of the claims to the novel and non-obvious products would be an undue burden on the applicants, and create an unnecessary "rework" application for the Patent Office. Moreover, the Examiner's apparent examination of the product claims (i.e., claims requiring the presence of novel and non-obvious primers) indicates that examination of the subject matter of Group II (in part, i.e., claim 37), and Groups III and IV (claims 43, 44, 45 and 46 due to their dependence on claims defining novel and non-obvious products) of the Decision dated June 18, 2004, was not an undue burden on the Examiner.

As for further clarification relating to the Decision, the same is understood to provide a new determination of alleged patentably distinct subject matter in the four (4) Groups identified spanning pages 2-3 of the Decision.

The Decision states that

"this petition [sic, Decision?] includes a new lack of unity determination which supplies the required PCT reasoning and addresses applicants' arguments, thus fulfilling the concern of item (3)." See, page 6 of the Decision.

The Decision further defines three alleged separately patentable Groups of subject matter in the form of Groups II-IV listed on page 5 of the Decision. The undersigned respectfully submits however that the Decision does not clearly articulate how the subject matter of these Groups are separately patentable. Further clarification in this regard is again requested.

Specifically, the Decision goes to some length to distinguish the subject matter of Group I from the subject matter of each of Groups II-IV however the Decision provides one paragraph, at the top of page 6 of the Decision, to conclude that the subject matter of Groups II-IV are separately patentable. Reconsideration and further clarification in this regard are requested.

The undersigned notes that the Decision groups claims to single probes or primers in Group II as apparently not being separately patentable subject matter. The combinations or collection of primers from Group II are then alleged to be separately patentable in defining the subject matter of Group III. Clarification is requested however as to how the combination of at least one patentable invention, presuming the individual primers are patentable, with another patentable or unpatentable individual subject matter (i.e., another primer) could define a separately patentable invention which either requires separate search or defines a separate special technical feature or has obtained separate status in the art as being subject matter of separate invention. Similarly, the Decision has defined a further separately patentable Group of subject matter (Group IV) which is a combination of the primers

and probes of Group II. Clarification and reconsideration is similarly again requested as to how the subject matter of Group IV, which contain the subject matter of Group II of the Decision, could be separately patentable from the subject matter of the individual components defined in Group II.

The undersigned notes that the original restriction requirement of January 15, 2002 appears to have appreciated that claims "drawn to primers, probes, and kits" defined a single invention. See, page 2 of the Office Action dated January 15, 2002.

At a minimum, the Commissioner is requested to provide a clear statement for the record. Clarification of the separate patentability of the subject matter of Groups II-IV of the Decision is requested.

The Commissioner is further requested to facilitate return of a completely initialed copy of the PTO 1449 Form filed March 13, 2001, pursuant to MPEP § 609, which lists, among other things, document DE 197 456. See, pages 6-7 of the Remarks of the Amendment filed March 10, 2003.

The Commissioner is requested to contact the undersigned in the event anything further is required for grant of the present Renewed Petition.

Respectfully submitted,

NIXON & VANDERHYTE P.C.

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SECOND REQUEST FOR RECONSIDERATION
May 8, 2006

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